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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,094	10/31/2003	Claus Bruestle	M09699	1010
7590	10/15/2004		EXAMINER	
William D. Lanyi, Esq. Mercury Marine W6250 Pioneer Road P.O. Box 1939 Fond du Lac, WI 54936-1939			WRIGHT, ANDREW D	
			ART UNIT	PAPER NUMBER
			3617	
DATE MAILED: 10/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/698,094	BRUESTLE, CLAUS 
	<b>Examiner</b>	<b>Art Unit</b>
	Andrew Wright	3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 July 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,4,6-16,18-22,24,25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 22,24,25 and 27-31 is/are allowed.
- 6) Claim(s) 1,3,4,6,7,11,15,16 and 18 is/are rejected.
- 7) Claim(s) 8-10,12-14 and 19-21 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 6 is objected to. Claim 6 recites "a rotatable air deflection device" in line 2. Claim 1 previously recites "a rotatable valve plate". It is improper to positively recite the same element twice. Claim 6 is further objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As already noted, claim 6 only recites that which was already recited in claim 1.
2. Claim 15 is objected to. Claim 15 depends from cancelled claim 2. It will be assumed that claim 15 depends from claim 1. Appropriate correction is required.
3. Claim 16 is objected to. Line 9 reads: "through said air passage. passage; and...". The text "passage." should be deleted.
4. Claim 22 is objected to. Line 9 reads: "an outlet of said air passage. passage; and...". The text "passage." should be deleted.
5. Claim 27 is objected to. Claim 27 recites "a rotatable air deflection device" in line 2. Claim 22 previously recites "a rotatable valve plate". It is improper to positively recite the same element twice. Claim 27 is further objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As already noted, claim 27 only recites that which was already recited in claim 22.

***Double Patenting***

6. Claim 8 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 22. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 4, 6, 7, 11, 15, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 2-212295) in view of Saito (US 6,726,512). Kato discloses a cowl with a cavity for receiving an engine. An opening (not numbered) bounded by gasket (44) is formed in the top portion of the cowl (figure 3). The cavity forms an air passage that takes air from the opening to the intake for the engine. Door (50) is an air control mechanism that can be in a first position (closed) or a second position (open). The door controls air flow through the passage. The door constitutes a rotatable valve plate. Kato does not disclose that the engine has a throttle body. Saito discloses an outboard engine with a cowl that defines a cavity (62). An engine is

disposed within the cavity. The engine has a throttle body (118). The engine has an intake conduit (120) in fluid communication with the throttle body. The cavity (62) constitutes an air passage between the intake openings in the cowl (60) and the intake passage (120) (lines 33-36 of column 4, and lines 63-67 of column 5). Since Kato does not disclose the specifics of the engine in his invention, one making and using the invention of Kato would necessarily need to provide an engine. It would be obvious to look to the prior art for such an engine. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the Saito engine in the outboard motor arrangement shown by Kato. The motivation would be to use a known engine with the cowl shown by Kato.

9. Regarding claim 3, Saito discloses the engine has an intake conduit (120) in fluid communication with the throttle body.

10. Regarding claim 4, the air from the inlet can reach the engine intake, so the air passage is a fluid connection between the opening and the throttle body.

11. Regarding claim 6, the plate (50) is a rotatable air deflection device.

12. Claim 7, the door (50) is proximate the opening.

13. Claim 11, the internal surfaces of the cowl form the air passage.

14. Regarding claim 15, the engine is part of an outboard motor.

15. Regarding claims 16 and 18, Kato in view of Saito contains all of the structural elements of the claims. Kato in view of Saito does not specifically disclose the recited method steps. The method steps, however, are inherent in the making and use of the modified invention of Kato. Therefore it would have been obvious to one having

ordinary skill in the art at the time the invention was made to devise the claimed method steps based upon the making and use of the modified invention of Kato. The motivation would be to make and use the modified invention.

***Allowable Subject Matter***

16. Claims 22, 24, 25, and 27-31 are allowed.
17. Claims 8-10, 12-14, and 19-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

18. Applicant's arguments with respect to claims 1, 3, 4, 6, 7, 11, 15, 16, and 18 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright  
Patent Examiner  
Art Unit 3617

*AW 10/12/07*  
ANDREW D. WRIGHT  
PRIMARY EXAMINER